



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Cornelius Borst et al.

Examiner: R. Nasser

Serial No.: 09/678,203

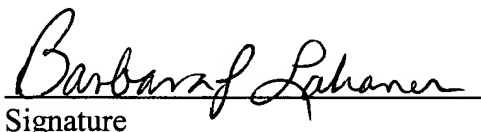
Group Art Unit: 3736

Filing Date: 10/02/2002

Docket No.: P-3875.09

Title: METHOD AND APPARATUS FOR TEMPORARILY IMMOBILIZING A LOCAL AREA OF TISSUE

**CERTIFICATE OF MAILING UNDER 37 CFR 1.8:** I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20<sup>th</sup> day of August, 2004.



Signature

Barbara J. Lakanen

Printed Name

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

Dear Sir:

In compliance with the duty imposed by 37 C.F.R. Section 1.56, and in accordance with 37 C.F.R. Section 1.97 *et. seq.* the materials enclosed herewith are brought to the attention of the Examiner as possibly being of interest in connection with the above-identified patent application.

The Examiners attention is also directed to the following:

1. U.S. Pat. No. 5,836,311 is in the process of Reexamination, in Reexam. Appl. No. 90/005,994, filed May 3, 2001.

2. U.S. Pat. No. 5,927,284 is in the process of Reexamination, in Reexam. Appl. No. 90/005,995, filed May 3, 2001.

The Examiner's attention is also directed to U.S. Pat. Appl. No. 09/678,203, filed, October 2, 2000, a copy of which is enclosed for the Examiner's convenience.

U.S. Patent No. 5,836,311 was previously involved in litigation between the patent owner, Medtronic, Inc. (plaintiff), and Guidant Corporation and Guidant's wholly-owned subsidiary CardioThoracic Systems, Inc. in the U.S. District Court for the Northern District of California (Civ. Action No. C-00-20144-EAI, renumbered C-01-02494-SBA). That litigation is now settled. No decision regarding infringement or validity of the patent was entered in that litigation. In that litigation, allegations were made on behalf of Guidant that animal studies were conducted by Charles S. Taylor prior to September 20, 1995 in which a "Turtle Shell" device was used to stabilize the a beating heart using suction. A summary of the alleged work was presented in the form of an affidavit of Charles S. Taylor, which was submitted as paper number 13 in U.S. Serial No. 08/603,328 along with an amendment after final (paper number 12) arguing the applicants' position that the work described in the affidavit constituted a reduction to practice. A copy of the affidavit and the amendment are supplied herewith for the Examiner's consideration. Although there has been no judicial determination that the work alleged by Charles S. Taylor constitutes prior art to the present patent, the patent owner wishes the Examiner to examine the present application in light of the allegations in the affidavit of Charles S. Taylor are true. The application owner is submitting this material in an abundance of candor and not as an admission of the truth of any of the facts set forth in the affidavit or an admission that what is described in the patent is prior art to the patent in reexamination. The application owner submits that the claims herein are properly patentable over the affidavit.

Consideration of each of the documents enclosed or referenced herein or listed on the attached Form 1449 is respectfully requested. Pursuant to the provisions of M.P.E.P. Section 609, Applicant further requests that a copy of the Form 1449, marked as being considered and initialed by the Examiner, be returned with the next Official Communication.

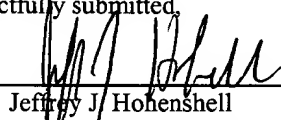
Applicants also note that a previous information disclosure statement was mailed in this case on July 30, 2002.

Please charge \$180.00 to Deposit Account No. 132546 for the fee required for the submission of this Information Disclosure Statement. Please charge any additional required fees or credit any overpayment to Deposit Account No. 132546.

Registration Number 34,109	Telephone Number 763-391-9661
Date August 20, 2004	

Respectfully submitted,

By

  
\_\_\_\_\_  
Jeffrey J. Hohenshell  
Senior Patent Counsel

**Serial No.: 10/137,159**

**Filing Date: 04-30-2002**

Group: 3736

AUG 23 2004

**Examiner**  
**Initial**

Document Number

**Date**

Name \_\_\_\_\_

## Class

SubClass

Filing Date If  
Appropriate

2003/0078470

04-24-2003

Borst et al

600

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2002/0124856

09-12-2002

Borst et al

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08-29-2002

Borst et al

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## Document Number

Date \_\_\_\_\_

Country

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**Class**

SubClass

### Translation

**Ye**

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EP 0993 806A2

09-15-1999

EP

WO 98/49947

11-12-1998

PCT

**EXAMINER**

**Date Considered**

**\*Examiner:** Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.